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14 UNITED STATES DISTRICT COURT  
 15 CENTRAL DISTRICT OF CALIFORNIA  
 16 SOUTHERN DIVISION

17 JAMES R. GLIDEWELL DENTAL  
 18 CERAMICS, INC.,

19 Plaintiff,

20 vs.

21 KEATING DENTAL ARTS, INC.,

22 Defendant.

Case No. SACV11-01309-DOC(ANx)

**JAMES R. GLIDEWELL DENTAL  
 CERAMICS, INC.'S REPLY IN  
 SUPPORT OF GLIDEWELL'S  
 MOTION FOR PARTIAL  
 SUMMARY JUDGMENT AS TO  
 KEATING'S INVALIDITY  
 DEFENSE AND COUNTERCLAIM**

Hearing

Date: December 17, 2012  
 Time: 8:30 a.m.  
 Ctrm: 9D, Hon. David O. Carter

Pre-Trial Conf.: January 28, 2013  
 Jury Trial: February 26, 2013

23 AND RELATED  
 24 COUNTERCLAIMS.

25 **HIGHLY CONFIDENTIAL - FILED UNDER SEAL**  
 26 **(PURSUANT TO PROTECTIVE ORDER DATED JANUARY 30, 2012)**

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## I. INTRODUCTION

Desperately attempting to undermine the BruxZir mark's presumption of distinctiveness, Keating sets up imaginary shortcomings during the PTO's examination. Keating first manufactures an Internet search requirement, but none exists. Keating then says Glidewell withheld information from the Examiner, but admits elsewhere that this never happened. In truth, the Examiner did his job, the presumption remains strong, and Keating has come woefully short of overcoming it. Keating's mantra that "BruxZir" and "bruxer" are phonetic equivalents is irrelevant given that one means dental restorations and the other means people with a medical condition. Keating has precious little evidence that anyone has ever regarded "bruxer" as meaning crowns, and Keating even had to sheepishly retract its statement that the term can be found in dictionaries. Perhaps most telling of Keating's losing position is the fact the Keating completely ignores the need to prove genericness *as of April 2011*. Not a shred of Keating's evidence – not the expert reports, the thirteen dentists' declarations, the Frattura declaration, nor the dozens of third party webpages – is probative of genericness at this relevant time. The undisputed evidence, including Keating's own submissions, proves that BruxZir is both suggestive and has attained strong secondary meaning. For these reasons, the Court should grant summary judgment in favor of Glidewell as to Keating's First Affirmative Defense, and its Fourth Counterclaim, of invalidity.

## II. ARGUMENT

### A. The BruxZir Mark Is Not Generic, and Keating Has Failed to Establish a Genuine Issue of Material Fact to The Contrary

#### 1. Keating's Argument That the Trademark Office Did Not Properly Examine the BruxZir Mark Is Baseless

Because the BruxZir mark is registered, the mark enjoys a "strong presumption" of validity and Keating bears a "heavy" burden to overcome the presumption at summary judgment. (Dkt. #114 at 3:8-15; Dkt. #82-1 at 5:18-27)

Moreover, because the Examiner did not require a showing of secondary meaning, the BruxZir mark is presumed to be inherently distinctive; i.e., at least suggestive. (Dkt. #114 at 3:16-23; Dkt. #82-1 at 5:28-6:11) Keating attempts to undermine these presumptions by arguing that the Examiner failed to do his job properly. Keating's arguments have neither legal nor evidentiary support.

*First*, Keating says that the Examiner "did not do a routine Internet search." (Dkt. #118 at 1:12) But Keating identifies no requirement for such a search, nor any evidence that one is "routine." Even Keating's "expert," Boatright, does not say that an Internet search is required. Rather than requiring an Internet search, the pertinent TMEP provision, § 710.01(b), cautions an Examiner about refusing a registration (or requiring amendments) based upon Internet evidence without adequate precaution.<sup>1</sup> For example, it states that "the weight given to this evidence must be carefully evaluated, because the source may be unknown," and that "[a] list of Internet search results has little probative value." TMEP § 710.01(b). Keating simply imagines that an Internet search is required, much less "routine."

Moreover, other than a reference to its own proposed Statement of Uncontroverted Fact ("PSUF") 60, Keating does not say what information the Examiner would have found by an Internet search. (Dkt. #118 at 5:9) PSUF 60 is that "[i]n addition to Glidewell and Keating, many other companies have been using 'Brux' to refer to dental products for use with bruxers and 'Z' or 'Zir' to refer to dental products associated with Zirconia," and the cited support is a collection of webpages. (Dkt. #87-1 at 10:15-11:5) But this "evidence" is worthless. First, none

<sup>1</sup> Glidewell applied for the BruxZir mark on June 17, 2009. Dkt. #90-19 (Ex. 59). The application was assigned to Examiner Corwin on September 16, approved for publication on September 17, published in the *Trademark Official Gazette* on November 5, and registered on January 19, 2010. Dkt. #90-19 (Ex. 60, at KDA-002811-002813). The version of the Trademark Manual of Examining Procedure ("TMEP") that was applicable during the entire course of examination was the 5<sup>th</sup> edition, published on September 30, 2007. *See* [http://tess2.uspto.gov/tmdb/tmep\\_5ed/](http://tess2.uspto.gov/tmdb/tmep_5ed/) (visited Nov. 30, 2012). The 5<sup>th</sup> edition was replaced by a 6<sup>th</sup>, published on May 21, 2010. *See* [http://tess2.uspto.gov/tmdb/tmep\\_6ed/](http://tess2.uspto.gov/tmdb/tmep_6ed/) (visited November 30, 2012). References herein to the TMEP are to the 5<sup>th</sup> edition unless otherwise indicated.



1 of the pages are dated, (Dkt. #93-50; Dkt. #93-57 - #93-71), and there is no proof  
 2 that they were on the Internet in September 2009 during examination of the BruxZir  
 3 mark. Second, the pages are inadmissible for lack of competent authentication.  
 4 (Dkt. #115 at 1:11-5:1) Keating's expert does not attest that he printed the pages or  
 5 when, or that he has personal knowledge of their contents. (Dkt. #93 at ¶¶ 68, 75-  
 6 80, 82-90) Third, the evidence is hearsay, because it is offered to prove the truth of  
 7 the statements in the webpages. (Dkt. #115 at 5:2-23) These problems aside,  
 8 Keating does not explain how PSUF 60, or the "evidence" supporting it, would  
 9 have been material to examination of the BruxZir mark, much less caused rejection.

10 *Second*, Keating argues that the Examiner "failed to follow the usual  
 11 procedure, as recommended in the Trademark Manual of Examining Procedure,  
 12 §§ 814 and 1209.2 [sic – 1209.02], to ask if the term had any meaning in the  
 13 industry." (Dkt. 118 at 5:2-4) Keating again attempts to impose a non-existent  
 14 requirement; neither TMEP section requires such an inquiry. Section 814 states  
 15 that "sometimes" it is necessary for the examining attorney to request additional  
 16 information from an applicant, and, if so, the Examiner "may" do so. Section  
 17 1209.02 similarly provides that the Examiner "may" request additional explanation  
 18 to clarify the nature of the goods. Such requests are optional, not required.<sup>2</sup>  
 19 Keating has not proven that exercising the option is the "usual procedure."

20 *Third*, Keating argues that the Examiner "could not have known that, to the  
 21 relevant purchasing public – dentists – 'brux' means teeth grinding and 'zir' means  
 22 zirconia," and that "bruxers" were among the intended users of Glidewell's BruxZir  
 23 brand crowns. (Dkt. #118 at 5:7-13) This is both speculative and contrary to fact.

24  
 25 <sup>2</sup> Keating suggests that Glidewell hoodwinked the Examiner because Glidewell  
 26 "did not disclose," and "did not voluntarily offer," the suggestive meaning of  
 27 "BruxZir." (Dkt. #118 at 1:9; 5:5-6) Tellingly, Keating cites no TMEP provision  
 28 or other obligation requiring such disclosure. To the contrary, Keating elsewhere  
 admits that "a trademark applicant has no affirmative duty to disclose a mark's  
 meaning to the trademark examiner." (Dkt. #127 at 13:15-16)

1 TMEP § 710.01(b) provides that “[t]he examining attorney *must* check applicant’s  
2 own website for information about the goods or services.” (emphasis added).  
3 During July 1, 2009 - January 19, 2010, Glidewell’s website featured the BruxZir  
4 mark and descriptions of BruxZir brand restorations, stating that they are made of  
5 zirconia and are indicated for “bruxers,” i.e., patients suffering from bruxism.  
6 Shuck 2nd Suppl. Decl. ¶¶ 3-8. The Examiner presumably did his job, followed  
7 § 710.01(b), and saw these descriptions when he visited Glidewell’s website in  
8 September of 2009. Knowing that “bruxers” were among the intended users, he  
9 allowed the BruxZir mark without requiring any showing of secondary meaning.

10 *Fourth*, the Examiner performed searches in the PTO’s Trademark Electronic  
11 Search System (“TESS”) that would have turned up several “brux” related  
12 trademarks, providing information about the meaning of “brux” in the dental field.  
13 In particular, on September 17, 2009, the Examiner entered the following search  
14 string: “\*brux\*[bi,ti] not dead[ld].” Dkt. #90-19 (Ex. 60, at KDA-002820).  
15 Entering this string into TESS search window today results in 28 records. (Shaw  
16 Decl. ¶ 4, Ex. 111). (For the Examiner, over three years ago, it resulted in 13  
17 records. (Dkt. #90-19 (Ex. 60, at KDA-002820)). One of the records that would  
18 have appeared for the Examiner is the BRUX-EZE mark (Reg. No. 2473238),  
19 registered on July 31, 2001 for “[d]ental appliances, namely removable occlusal  
20 overlays, fixation devices and the like, used for the treatment of bruxism and  
21 temporomandibular joint dysfunctions.” (Shaw Decl. ¶ 5, Ex. 112). Thus, the  
22 Examiner’s TESS search revealed the association between “brux” and bruxism.

23 **2. Keating’s “Phonetic Equivalence” Argument Is Inapposite,**  
24 **Because Glidewell Is Using The BruxZir Mark to Sell Crowns and**  
25 **Bridges, Not People Suffering from Bruxism**

26 Keating next argues that “Glidewell ignores the undisputed evidence of  
27 phonetic equivalency of its mark with the term ‘bruxer,’ which Glidewell admits is  
28 the generic name for a person who bruxes and the intended user of Glidewell’s

1 BruxZir crowns. As the phonetic equivalency [sic] of the generic name for the  
 2 intended user of its BruxZir product, the mark is generic as a matter of law.” (Dkt.  
 3 #118 at 5:17-22) This argument has several fatal flaws.

4 *First*, and most obviously, Glidewell sells dental restoration products, not  
 5 people who brux. “Bruxer” may be a common term for people who suffer from  
 6 bruxism, but Keating has failed to prove that “bruxer” was a generic term for  
 7 zirconia dental restorations as of April 2011. Indeed, the Court will search  
 8 Keating’s PSUFs in vain for a single assertion that “bruxer” is a term that means  
 9 any type of dental restoration. (Dkt. #87-1) After first telling the Court in its  
 10 opposition brief that “Bruxer [is] in the medical dictionary,” Keating was forced  
 11 retract this erroneous statement by Notice of Errata. (Dkt. #118 at 20:24; Dkt.  
 12 #119) It is undisputed that *none* of the multiple dictionaries before the Court define  
 13 “bruxer” as a dental restoration. (SAF 26; Dkt. #124 at 20:22).<sup>3</sup> Given the absence  
 14 of evidence that “bruxer” means any type of dental restoration, and given that  
 15 Glidewell indisputably does not sell bruxers (i.e., people who brux), whether  
 16 “bruxzir” and “bruxer” are phonetic equivalents is irrelevant to validity.

17 *Second*, Keating’s reliance upon *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178  
 18 (5<sup>th</sup> Cir. 1980), is misplaced. (Dkt. #118 at 5:22-27) In that case, the appellate  
 19 court *reversed* the district court’s cancellation of the registered mark “Larvacide” as  
 20 generic. 617 F.2d 1178, 1190 (5<sup>th</sup> Cir. 1980). As the court observed: “plaintiff  
 21 used its mark on products that are intended to kill many forms of animal life, not  
 22 merely larvae; it is more properly characterized as a ‘varminticide’ than a ‘larvacide.’  
 23 Nevertheless, since plaintiff’s products do kill larvae, its mark may be said to be at  
 24 least descriptive of its products.” 617 F.2d at 1190. Here, neither Glidewell’s nor  
 25 Keating’s product is a “bruxer,” and neither of their respective products are

26  
 27 <sup>3</sup> References to the “SAF” are to Glidewell’s statement of genuine disputes and  
 28 additional material facts, more particularly to the portion of that document under  
 heading “II.” (Dkt. #114-1 at p. 95 of 130)

1 marketed exclusively for use in treating patients with bruxism. Dkt. #90-1 (Ex. A  
 2 (Doneff Decl., ¶ 11), Ex. B (Newman Decl., ¶ 11), Ex. C (Cohen Decl., ¶ 11), Ex.  
 3 D (Luke Decl., ¶ 11), Ex. E (Bell Decl., ¶ 11), Ex. F (Toca Decl., ¶ 11), and Ex. Q  
 4 (Michiels Decl., ¶ 11)); #90-4 (Ex. 11); #90-7 (Exs. 21-22); #91-10; #91-14; #91-  
 5 48. *Soweco* is inapposite, other than to support descriptiveness over genericness.

6 *Third*, even if phonetic equivalence of “BruxZir” and “bruxer” were a  
 7 material issue, which it is not, there is a genuine dispute of fact. There is evidence  
 8 that at least some dental labs regard “BruxZir” and “bruxer” as being pronounced  
 9 differently. (Dkt. #91-24 at p. 5 of 11; Dkt. #91-6 at 214:3-220:21) [REDACTED]

10 [REDACTED] r [REDACTED]  
 11 [REDACTED] Keating vigorously argues that, in his  
 12 videos, Dr. DiTolla “pronounces the name BruxZir and the dental term bruxer  
 13 identically.” (Dkt. #87-1 at ¶ 48) [REDACTED]

14 [REDACTED]  
 15 [REDACTED]  
 16 [REDACTED] Dr. DiTolla’s credibility, and whether the videos show phonetic equivalence,  
 17 are judgment calls for the fact finder to determine at trial, not for the Court to make  
 18 at summary judgment. *E.g., Anderson v. Liberty Lobby*, 477 U.S. 242, 255 (1986).  
 19 If phonetic equivalence were a material issue for validity – which, again, it is not –  
 20 genuine disputes would at least preclude summary judgment for Keating.

21 Finally, Keating asserts that “Glidewell’s adoption of a misspelling of  
 22 ‘bruxer’ for its mark and assertion of its BruxZir mark against competitors using  
 23 ‘brux’ and ‘bruxer’ is evidence of genericness because it deprives competitors of  
 24 the right to identify their products as intended for bruxers.” (Dkt. #118 at 6:7-10)  
 25 The cited cases do not support this *non sequitur*, and they are, in any event,  
 26 distinguishable. For example, in *Nupla Corp. v. IXL Mfg. Co.*, the court affirmed  
 27 summary judgment of genericness of the CUSH-N-GRIP mark “[b]ased on  
 28 overwhelming documentary evidence of record showing widespread and long-time

1 prior us of the CUSHION-GRIP mark in the hand tool industry.” 114 F.3d 191,  
 2 196 (Fed. Cir. 1997). There is no comparable evidence as to “bruxer” here; indeed,  
 3 Keating as submitted *no* admissible evidence that the word was used in the dental  
 4 industry prior to April of 2011 as a term for dental restorations. In addition,  
 5 CUSH-N-GRIP and CUSHION-GRIP had the same meaning, differing only in  
 6 spelling. Here, “BruxZir” and “bruxer” do not mean the same thing; the former is a  
 7 dental restoration product, while the latter is a person with a medical condition.

8 To the extent Keating is arguing that competitors need to use “bruxzir” or  
 9 “bruxer” as trademarks for their products, or that Glidewell has sought to eliminate  
 10 all use by competitors of the word “bruxer,” the argument founders on the evidence.  
 11 As discussed in Glidewell’s prior briefs, competitors like Showcase Dental and  
 12 Drake Precision Laboratory do not need to use these terms as trademarks. (Dkt.  
 13 #82-1 at 17:13-19:3; Dkt. #114 at 19:3-20:22) These labs, and Keating, remain free  
 14 to use “bruxer” in a manner *other than as a trademark*. For example, Drake  
 15 markets its full contour zirconia crown under the mark, ZIR-CAST. (Dkt. #93-32)  
 16 Among other descriptions of the product, Drake states that the product is  
 17 “recommended for Bruxers and Grinders.” (Dkt. #93-32) Glidewell has agreed  
 18 that such use is permissible. (Dkt. #91-5 at 82:19-83:5 & 143:11-19; Dkt. #91-6 at  
 19 211:8-212:12) Thus, Glidewell’s trademark enforcement does not “deprive[]  
 20 competitors of the right to identify their products as intended for bruxers.”

21 **3. Keating Has Provided No Evidence that “BruxZir” is Generic**

22 **a. Glidewell Need Not “Establish That the Primary**  
 23 **Significance of Its Mark Is To Identify Glidewell”**

24 Keating misconceives the law when it argues that Glidewell must “establish  
 25 that the primary significance of its mark is to identify Glidewell.” (Dkt. #118 at  
 26 6:21-22) ““To determine whether a term has become generic, we look to whether  
 27 consumers understand the word to refer only to a particular producer’s goods or  
 28 whether the consumer understands the word to refer to the goods themselves.””



1 *Yellow Cab*, 419 F.3d at 929 (citation omitted). If a buyer understands the term to  
 2 be identified with a particular producer's goods, it is not generic. *Id.* This so even  
 3 if the source is anonymous to consumers. *See* 15 U.S.C. § 1127; *Maljack Prods.,*  
 4 *Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996); 2  
 5 McCarthy on Trademarks & Unfair Comp., § 15:8 (4th ed.). So, Glidewell need  
 6 not "establish that the primary significance of its mark *is to identify Glidewell.*"

7 **b. Keating Ignores the "Crucial Date" For Determining**  
 8 **Genericness**

9 Keating next argues that it as "provided substantial evidence that dentists use  
 10 the word 'bruxzir' as a generic reference to a type of crown." (Dkt. #118 at 8:13-  
 11 15) Keating cites to various types of "evidence," but none is probative of  
 12 genericness. Critically, Keating ignores that "[t]he crucial date for the  
 13 determination of genericness is the date on which the alleged infringer entered the  
 14 market with the disputed mark or term." *Yellow Cab Co. of Sacramento v. Yellow*  
 15 *Cab Co. of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005); *see also Nora*  
 16 *Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 164 F.3d 736, 744 (2d Cir. 1998);  
 17 McCarthy § 12:17.50. Here, Keating "adopted and began using" its KDZ Bruxer  
 18 mark "[i]n approximately April 2011." (SAF 86). Keating therefore must show  
 19 that, *as of April 2011*, dentists understood "bruxzir" to refer to the genus of dental  
 20 restoration products including crowns, bridges, and the like. Evidence of dentists'  
 21 understanding *now*, or at other points *after* April 2011, is irrelevant.

22 **(i) The Eggleston Report Is Not Probative of**  
 23 **Genericness as of April 2011**

24 Keating first cites the Eggleston expert report. (Dkt. #118 at 8:16) Aside  
 25 from the fact that Dr. Eggleston relies largely upon undated and unauthenticated  
 26 hearsay webpages, his opinion is not probative of genericness because he  
 27 completely fails to address genericness as of April 2011. (Dkt. #93-1)  
 28

(ii) **The Thirteen Dentists' Declarations Are Not Probative of Genericness as of April 2011**

Keating next cites declarations from thirteen dentists that, Keating says, “have written ‘BruxZir,’ or variations thereof on prescription forms as a generic reference to an all-zirconia crown.” (Dkt. #118 at 8:17-23) This testimony is not probative because not a single one of these doctors say that they regarded “bruxzir” or “bruxer” as being generic terms for zirconia crowns as of April 2011. Their declarations each reveal that, if they regarded these terms as generic, they did so as of later points in time. (SAF 87) Such “evidence” is irrelevant, and its admission would be confusing and prejudicial, as it would lead to an assessment of genericness as of the incorrect time period. (Dkt. #115 at 5:24-8:3)

(iii) **The Frattura Declaration Is Not Probative of Genericness as of April 2011**

Keating next points to a declaration from Carol Frattura of Showcase Dental, which, according to Keating, “also receives (and fills) orders from dentist-customers who write ‘BruxZir’ on prescription forms as a generic reference to an all-zirconia crown.” (Dkt. #118 at 8:23-26) But the prescription forms attached to Frattura’s declaration are not probative of genericness. The majority post-date April 2011. (SAF 89) One is undated. (SAF 90) The remainder show that dentists used terms other than “bruxzir” or “bruxer” when ordering zirconia crowns prior to April 2011. (SAF 91) This supports Glidewell, not Keating.

(iv) **The “Evidence” of “Third Party Use” Is Not Probative of Genericness as of April 2011**

Finally, Keating cites what it characterizes as “substantial evidence showing widespread third party use of the terms ‘bruxer’ and ‘brux’ in connection with dental crowns.” (Dkt. #118 at 8:27-9:2) But whether the terms “bruxer” and “brux” have been used “in connection with dental crowns” is not the issue. The issue is whether, as of the “crucial date ... [of when] the alleged infringer entered

the market with the disputed mark or term,” “consumers underst[ood] the word to refer only to a particular producer’s goods or whether the consumer[s] underst[ood] the word to refer to the goods themselves.” *Yellow Cab*, 419 F.3d at 928-29. Keating’s proffered “evidence” – contained in Keating’s PSUF 60-62 (Dkt. #118 at 9:2) – is not probative of this.

(a) *Keating’s Statement of Uncontroverted Fact 60,  
Even If True, Does Not Support Genericness*

Keating’s PSUF 60 is that, “[i]n addition to Glidewell and Keating, many other companies have been using ‘Brux’ to refer to dental products for use with bruxers and ‘Z’ or ‘Zir’ to refer to dental products associated with zirconia.” (Dkt. #87-1 at 10:15-17) Keating then lists third-party product names, purportedly evidenced by a collection of third-party webpages. (Dkt. #87-1 at 10:18-11:5) Even putting aside the fatal evidentiary problems,<sup>4</sup> the import of this “evidence” is unclear. None of the listed product names includes “bruxzir” or “bruxer,” so this “evidence” says nothing about whether these terms were generic as of April 2011. At most, the “evidence” supports Glidewell’s argument that the BruxZir mark is suggestive because “brux” and “zir” suggest certain features to dentists.

In any event, as noted in Glidewell’s opening brief (Dkt. #82-1 at 13:4-19), the Court must focus on the trademark as a whole, because a composite mark may be distinctive even though its components individually are not. *Reno Air Racing Ass’n, Inc. v. McCord*, 452 F.3d 1126, 1135 (9th Cir. 2006); *see also Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 978 (9th Cir. 2010) (“[T]he combination of generic terms may, in some instances, result in a distinctive mark.”). Here, Glidewell’s registered mark is BruxZir, not “brux” or “zir.” Keating’s mark is KDZ Bruxer, not “brux” or “zir.” Whether “brux” or “zir” alone

<sup>4</sup> As explained in more detail in Glidewell’s Statement of Objections to Evidence Submitted in Support of Keating’s Motions for Summary Judgment, the evidence that Keating cites in support of PSUF 60-62 is inadmissible for three independent reasons: (1) it has not been competently authenticated, (2) it is hearsay, and (3) it is irrelevant and prejudicial. (Dkt. #115)

are protectable, or are immune from infringement liability, are not at issue.

**(b) *Keating's Statement of Uncontroverted Fact 61,  
Even If True, Does Not Support Genericness***

Keating's PSUF 61 is that, "[i]n addition to Glidewell and Keating, many other dental laboratories have been offering all-zirconia crowns under a variety of names, including names with "Brux," "Zir," or variations thereon." (Dkt. #87-1 at 11:7-9) Following this assertion is a list of third parties and associated product names, again purportedly proven with webpages. (Dkt. #87-1 at 11:10-18) Once again, Keating's supporting "evidence" does not support genericness.

First, according to PSUF 61, more than half of the listed labs do not use "bruxzir" or "bruxer" at all, whether alone or in combination with other words. These include Assured Dental Lab (Z-Brux), Authentic Dental Lab (Brux), Barth Dental Lab (Z-Brux), Burbank Dental (Zir-Max), California Dental Arts (ZirFit), CDLLab (ZerisBRUX), Continental Dental (Full Zirconia for Bruxing Patients), Diadem Precision Technology (Diazir), Drake Dental (Zir-Cast), Expertec (Full-Z), GPS Dental Lab (GPS BruxArt), Kastle Mills (ZirCrown), Pittman Dental (ZirCAM All-Zirconia), R-dent Dental Laboratory (R-Brux), Somer Dental Labs (Full Contour Zir), Summers Dental Lab (BruxThetix), Sun Dental Labs (Suntech Full Zirconia), Technics Dental Lab (Tech/ZIR FC), and Zahn Dental (Zirlux). (Dkt. #87-1 at 11:10-18) Even if these companies were selling these products as of April 2011 – which Keating has not proven – this says nothing about whether "bruxzir" or "bruxer" were generic for zirconia dental restorations as of April 2011.

Second, the proffered evidence as to the majority of the remaining listed labs is not probative of genericness of "bruxzir" or "bruxer" as of April 2011, because it either post-dates April 2011 or is undated. *See* Dkt. #91-31 (Advanced Dental Lab (BruxZir), Mar. 2012); Dkt. #91-29 (China Dental Outsourcing (Bruxer All Zirconia), May 2011); Dkt. #91-39 (China Dental Outsourcing (All Zirconia for Bruxers), Sept. 2012); Dkt. #93-55 (Cosmetic Dentistry of SA (Bruxer Crown),

1 Sept. 2012); Dkt. #93-44 (Infinity Dental Lab (Bruxer Crowns), Sept. 2012); Dkt.  
 2 #91-32 (Old Dominion Milling Corp. (Bruxzer), Aug. 2012); Dkt. #91-30 & 91-38  
 3 (Showcase Dental Lab (Zir-Bruxer), Jan. 2012); Dkt. #93-47 (York Dental Lab  
 4 (Bruxer), Aug. 2012); Dkt. #91-43 (Dani Dental (Full Zirconia (Bruxer)), undated );  
 5 Dkt. #93-56 (Pittman Dental (Bruxer Crown), undated); Dkt #91-42 (Trachsel  
 6 Dental (All Zirconia Bruxer), undated). Keating's failure to substantiate that any of  
 7 these labs were using "bruxzir" or "bruxer" as of or prior to April 2011 renders this  
 8 evidence worthless for proving that these terms are generic at the relevant time.

9 Finally, the proffered evidence as to the remaining two listed labs is  
 10 insufficient to defeat summary judgment for Glidewell. As to Mascola Esthetics  
 11 (Xtreme Bruxer), Keating has submitted only a prescription form that its expert  
 12 purportedly pulled from the internet. (Dkt. #93 at ¶ 64; Dkt. #93-46) For the  
 13 reasons stated in Glidewell's statement of evidentiary objections, this "evidence" is  
 14 inadmissible hearsay that also lacks authentication. (Dkt. #115) Even aside from  
 15 that problem, it is not probative of *when* Mascola Esthetics began using "Xtreme  
 16 Bruxer," for how long it used "Xtreme Bruxer," and whether such use evidences  
 17 generic use rather than intentional infringement. As for Fusion Dental Lab, the  
 18 proffered evidence establishes at most that the lab used "Full Solid Bruxer  
 19 Zirconia" in January 2011, was asked by Glidewell in January 2011 and again in  
 20 April 2011 to cease such use, and that Fusion Dental Lab thereafter stopped using  
 21 "Full Solid Bruxer Zirconia." (SAF 100). This is not probative of whether Fusion  
 22 Dental Lab used "bruxer" generically or instead intentionally infringed Glidewell's  
 23 mark. Likewise, it says nothing about whether *dentists* regarded "bruxzir" or  
 24 "bruxer" as generic terms for zirconia crowns as of April 2011. For all these  
 25 reasons, this evidence is insufficient to support a finding of genericness.

26 (c) *Keating's Statement of Uncontroverted Fact 62,*  
 27 *Even If True, Does Not Support Genericness*

28 Finally, PSUF 62 states: "[t]hese dental laboratories prominently promote



1 their all-zirconia crowns for use by bruxers,” followed by a subset of the labs listed  
 2 in PSUF 61, with citations to the same inadmissible webpage evidence. (Dkt. #87-  
 3 1 at 12:19-13:5) Again putting aside the evidentiary problems, this “evidence” does  
 4 not prove that “bruxer” or “bruxzir” were generic as of April 2011.

5 First, all of the cited evidence is either undated or it post-dates the relevant  
 6 time period by more than a year. (Dkt. #91-37 (Barth Dental Labs, Aug. 2012);  
 7 Dkt. #93-39 (California Dental Arts, undated); Dkt. #91-39 (China Dental  
 8 Outsourcing, Sept. 2012); Dkt. #93-32 (Drake Dental, undated); Dkt. #93-29  
 9 (Expertec, undated); Dkt. #93-44 (Infinity Dental Lab, Sept. 2012); Dkt. #93-30  
 10 (Sun Dental Labs, undated); Dkt. #93-47 (York Dental Lab, Aug. 2012))

11 Second, aside from three – China Dental Outsourcing, Infinity Dental Lab,  
 12 and York Dental Lab – the listed labs do *not* use the terms “bruxer” or “bruxzir”  
 13 within their trademarks. This shows that the BruxZir mark is suggestive rather than  
 14 generic or descriptive. *See Zobmondo Enter., LLC v. Falls Media, LLC*, 602 F.3d  
 15 1108, 1117 (9th Cir. 2010) (noting that evidence that competitors do not need to use  
 16 the mark can “strongly favor” suggestiveness). At least one of the remaining three,  
 17 York Dental Lab, is clearly a Glidewell knock-off. (Dkt. #93-47 (copying  
 18 Glidewell’s tagline, “more brawn than beauty”)). This supports distinctiveness, not  
 19 genericness. *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9<sup>th</sup> Cir. 1989)  
 20 (“[P]roof of copying strongly supports an inference of secondary meaning.”).

21 Finally, to the extent that this evidence tends to show that labs “promote their  
 22 all-zirconia crowns for use by bruxers,” as Keating contends, the evidence also  
 23 shows that “bruxer” means *patients who suffer from bruxism*, and does not mean  
 24 zirconia dental restorations. The generic term for the latter is exactly the term  
 25 Keating uses in PSUF 62: “all-zirconia crowns.” The evidence additionally  
 26 bolsters the point made above, that Glidewell’s trademark does not foreclose  
 27 competitors from using the term “bruxer” to describe their products, as long as they  
 28 do not use the word in a *trademark* that is confusingly similar to BruxZir.

c. **Keating Has Failed to Produce A Survey**

As Keating states, “[s]urveys are commonly used to probe consumer perceptions as to the generic-trademark dividing line.” (Dkt. #118 at 7:9-10) Because the BruxZir mark is registered, Keating bears a “heavy” burden to overcome the “strong presumption” of distinctiveness. *Zobmondo Enter.*, 602 F.3d at 1113, 1115, 1121; *see also, e.g., Reno Air Racing*, 452 F.3d at 1135. Many courts have noted the importance of proffering competent survey evidence to overcome this presumption. *E.g., Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 521 (S.D.N.Y. 2009) (“Overcoming this presumption of validity requires evidence such as properly conducted consumer surveys and proof of generic use of the mark by competitors, the mark’s owner, or third parties.”); *see also Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638 (Fed. Cir. 1991); *Cascade Mfg. Sales, Inc. v. Providnet Co. Trust*, 2008 WL 4889716, at \*3 (W.D. Wash. Nov. 12, 2008); *Heroes, Inc. v. Boomer Esiason Hero’s Found., Inc.*, 43 U.S.P.Q.2d 1193 (D.D.C. 1997). As McCarthy notes, “[c]onsumer surveys have become almost de rigueur in litigation over genericness.... A litigant who alleges that a designation is not a valid trademark because it is perceived as a generic name of a product or service and does not introduce a survey to support this challenge may be viewed as less than serious by some judges.” McCarthy § 12:14.

Presuming an interest in appearing fully “serious” to the Court, it is surprising that Keating has introduced no genericness survey. The absence of a survey, in view of Keating’s financial ability to obtain one, raises an inference that the results would not have been favorable to Keating. *See Playboy Enters. v. Netscape Comms. Corp.*, 55 F. Supp. 2d 1070, 1084 (C.D. Cal. 1999); *Cairns v. Franklyn Mint Co.*, 24 F. Supp. 2d 1013, 1041-42 (C.D. Cal. 1998).

d. **Glidewell’s Promotional Materials and Activities Do Not “Establish Genericness of The Mark”**

Keating next says that Glidewell’s videos and presentations by Glidewell

employees “establish[] genericness of the mark.” (Dkt. #118 at 9:3-4) In particular, Keating argues that Glidewell’s pronunciation of “BruxZir” in these materials, and occasional use of the term as a noun, “establish Glidewell’s own generic use.” (Dkt. #118 at 9:18-25) The argument is frivolous.<sup>5</sup>

That a product may be called by its given name does not negate its function as a mark or render it generic, so long it is used to identify a product of a single source. *See In re DC Comics, Inc.*, 689 F. 2d 1042, 1054 (C.C.P.A. 1982). “The fact that buyers often call for or order a product by a term does not necessarily evidence that the term is a ‘generic name.’ For example, if at a lunch counter one says, ‘I’ll have a cheeseburger and a COKE.’ Or if a new care buyer brags to a neighbor, ‘I’ve just been polishing up my new FORD!’ Does the neighbor respond, ‘FORD? A FORD what?’ The generic names ‘cola’ and ‘car’ are understood and so, dropped in common speech. Such usage does not evidence genericness of COKE or FORD—quite the contrary. It shows that the terms are such strong, well-known trademarks that they need no generic name to convey the message. The generic name is understood by all and dropped off.” McCarthy § 12.8. Similarly, “occasional generic usage does not destroy a trademark. Indeed, often the use of a trademark as a generic noun illustrates the power of a trademark.” *Caesars World, Inc. v. Milanian*, 247 F. Supp. 2d 1171, 1194 (D. Nev. 2003).

Here, the BruxZir mark “is like Coca-Cola to dentists as it is a source identifier for products offered by the predominant supplier of solid zirconia crowns and material used to make solid zirconia crowns.” (SAF 94). Even assuming that Glidewell occasionally uses the BruxZir mark as a noun in its videos or other promotional materials, if this made the BruxZir mark generic, then “Ford” would be

<sup>5</sup> Also frivolous is Keating’s disparagement of testimony from Glidewell employees as “self-serving” and therefore “entitled to little weight,” (Dkt. #118 at 9:8-9), and of the dentists’ testimony as “not persuasive” because it is “based on their existing relationship with Glidewell,” (Dkt. #118 at 23:15-16). “Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict.” *Anderson*, 477 U.S. at 255.

generic because of television commercials exhorting consumers to “put a Ford in the driveway this holiday season,” and “Coke” would be generic because of advertisements exhorting consumers to “have a Coke and a smile.” This would be absurd, particularly given that the uses Keating points to as being “generic” are all in Glidewell’s *own promotional materials*. This context reinforces for consumers that there is a single source (Glidewell) of the BruxZir brand products promoted therein, particularly given that the mark is presented in association with the Glidewell Labs name. (SAF 92). It is implausible that a dentist would watch one of Dr. DiTolla’s videos, or attend a Glidewell presentation, and conclude that the BruxZir products discussed therein were anything other than Glidewell’s products.

e. **The Use of “BruxZir” by Glidewell’s “Authorized” Labs Does Not Render “BruxZir” Generic**

Keating next argues that Glidewell’s “authorized labs” program somehow “reinforces” that “the BruxZir mark *is not an indication of Glidewell as the source.*” (Dkt. #118 at 18:5 (emphasis in original)) The premise of this argument – that that consumers must know the identity of the source of goods sold under a mark in order for the mark to be distinctive and nongeneric – is legally incorrect. It is enough that consumers associate the mark with a single, albeit anonymous, source. *See* 15 U.S.C. § 1127; *Maljack*, 81 F.3d at 887; *McCarthy* § 15:8.

Keating’s argument is faulty in another important respect. “Where a registered mark ... is ... used legitimately by related companies, such use shall inure to the benefit of the registrant ..., and such use shall not affect the validity of such mark or of its registration ....” 15 U.S.C. § 1055. “The term ‘related company’ means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.” 15 U.S.C. § 1127. “[P]roperly licensed use by licensees will serve to fortify the legal and commercial strength of the licensed mark.” *McCarthy* § 18:45.50. “[T]here is no necessity for the name of the



1 licensor to appear on licensed uses of a mark owned by the licensor. That is,  
 2 licensed uses may properly contain only the licensed mark and the name of the  
 3 licensee.” McCarthy § 18:45. Here, Glidewell permits the authorized labs to use  
 4 the BruxZir mark and Glidewell exercises control over the nature and quality of  
 5 crowns they sell under the BruxZir brand. (SAF 95). Contrary to Keating’s  
 6 assertions, there is no “naked licensing” here. As a matter of law, the authorized  
 7 labs’ use of the mark “inure[s] to the benefit” of Glidewell, and it “shall not affect  
 8 the validity of [the] mark or of its registration.” 15 U.S.C. § 1055.

9 Keating’s argument is also factually unsupported. Virtually all of the  
 10 authorized lab web pages Keating submitted show that the authorized labs use the  
 11 BruxZir mark in a manner so as to indicate that it is associated with a single source.  
 12 (SAF 96). For example, many, such as OralDesigns, expressly identify themselves  
 13 as an “Authorized BruxZir Laboratory,” thereby conveying that they have been  
 14 “authorized” by a single source. (SAF 97). Others, such as Continental Dental  
 15 Labs of California, expressly identify Glidewell as the source, such as by stating  
 16 that “BruxZir® is a registered trademark of Glidewell Laboratories.” (SAF 98).  
 17 All or virtually all of the labs use the “®” symbol with the BruxZir mark, thereby  
 18 indicating to consumers that the mark is owned by a single source.

19 Moreover, Keating has submitted no evidence that the absence of the  
 20 Glidewell name from an authorized lab’s website has actually caused any dentists  
 21 to conclude that the lab’s BruxZir brand products have no association with a single  
 22 source (whether Glidewell or an anonymous single source). In fact, Glidewell  
 23 actively informs dentists of this association by (a) maintaining a public list of  
 24 authorized labs on its website; (b) sending, on a quarterly basis, an “Rx booklet” to  
 25 approximately 120,000 dentists across the country, listing all the authorized labs  
 26 and encouraging the dentists to use them to obtain BruxZir brand products; and  
 27 (c) doing periodic “E-blasts” and letter campaigns to “to bring the awareness of the  
 28 BruxZir brand and its benefits and what makes it better.” (SAF 99).



1           **4.     The Testimony Of Third-Party Dentists and Glidewell's Experts**  
 2           **Establishes Nongenericness**

3           **a.     Glidewell's Evidence Was Not Untimely**

4           Keating devotes a considerable portion of its brief to attempting to exclude  
 5           Glidewell's evidence of nongenericness, including the testimony of third party  
 6           dentists as well as the expert testimony of Dr. Goldstein, Dr. DiTolla, and Prof.  
 7           Franklyn. (Dkt. #118 at 13:19-14:14; 15:14-17:28) Keating's main thrust is that  
 8           this evidence was "untimely" because it was first disclosed on October 29. As to  
 9           the expert reports of Dr. Goldstein, Dr. DiTolla, and Prof. Franklyn, Keating also  
 10          argues that "opening reports were due on September 15, 2012 and rebuttal reports  
 11          were due on October 15, 2012." (Dkt. #118 at 15:15-16) But the Scheduling Order  
 12          requires only that all discovery, including expert discovery, be completed by the  
 13          discovery cut-off, October 29, 2012. (Dkt. #15) Although the parties, in their Rule  
 14          26(f) report, had proposed the expert report deadlines Keating cites, they were not  
 15          adopted by the Court and are not in the Scheduling Order. *Cf. Order, Etagz, Inc. v.*  
 16          *Quiksilver, Inc.*, No. SACV 10-300 DOC (MLGx) (C.D. Cal. Nov. 16, 2012), ECF  
 17          No. 179 ("The Minute Order from the scheduling conference sets only one date,  
 18          November 5, 2012, as the expert discovery cutoff. The Court declines to find that  
 19          the Minute Order also adopted all the sub-deadlines that were contained in the 26(f)  
 20          Report, given that the Minute Order only includes the November 5, 2012, expert  
 21          discovery cutoff date.") (Shaw Decl., ¶ 6, Ex. 113).

22          Glidewell's amended witness disclosures and expert reports were served by  
 23          the discovery cut-off, October 29, 2012. They are not, therefore, subject to  
 24          exclusion as "untimely." *See Order, Etagz, Inc. v. Quiksilver, Inc.*, No. SACV 10-  
 25          300 DOC (MLGx) (C.D. Cal. Nov. 16, 2012), ECF No. 179 (denying motion to  
 26          strike expert reports as untimely because report was served before discovery cut-off  
 27          date) (Shaw Decl., ¶ 6, Ex. 113); *see also Nuance Comms., Inc. v. ABBYY Software*  
 28          *House*, C 08-02912 JSW MEJ, 2012 WL 2838431 (N.D. Cal. July 10, 2012)

(denying motion to strike 25 witnesses disclosed on last day of discovery); *Russell v. Daiichi-Sankyo, Inc.*, CV 11-34-BLG-CSO, 2012 WL 1805038 (D. Mont. May 17, 2012) (holding that disclosure of fact witness made on day of discovery cut-off was timely) (Shaw Decl., ¶ 7, Ex. 114); Order, *ESM Techs., LLC v. Biova, LLC*, No. 10-3009-CV-S-RED (W.D. Mo. Mar. 21, 2012), ECF No. 209 (holding expert declaration and report filed on last day of discovery to be timely); *3Com Corp. v. Realtek Semi. Corp.*, C 03-2177 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24, 2008) (denying motion in limine to preclude testimony from third-party witnesses first disclosed on the final day of fact discovery); *Cyntegra, Inc. v. Idexx Labs., Inc.*, CV06-4170PSG(CTX), 2007 WL 5193736 (C.D. Cal. Sept. 21, 2007) (holding service of expert reports on the last day of discovery to be timely), *affirmed*, 322 F. App'x 569 (9th Cir. 2009); *Roe v. Nevada*, 621 F. Supp. 2d 1039, 1060 (D. Nev. 2007) (holding disclosure of fact witnesses on last day of discovery to be timely).

Moreover, if Keating were truly prejudiced by disclosure of these witnesses on the last day of discovery, it is prejudice that Keating manufactured. Glidewell informed Keating that it would make the witnesses under its control available for deposition, and would not oppose any effort by Keating to depose those witnesses not under Glidewell's control (i.e., the dentist fact witnesses). (Shaw Decl. ¶ 8, Ex. 115). Keating declined the offer. (Shaw Decl. ¶ 8, Ex. 115). Excluding Glidewell's witnesses would be particularly inappropriate under these circumstances. *See Garvey v. Kmart Corp.*, 2012 U.S. Dist. LEXIS 160006, at \*3 (N.D. Cal. 2012) (denying a motion to exclude fact witness disclosed after the discovery deadline, noting that movant had declined to depose the witness); *3Com Corp. v. Realtek Semiconductor Corp.*, C 03-2177 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24, 2008) (denying motion in limine to exclude third-party witnesses disclosed on last day of fact discovery because movant never sought agreement or leave of court to subpoena witnesses after discovery cut-off); *cf. Roe v. Nevada*, 621 F. Supp. 2d 1039, 1060 (D. Nev. 2007) (rejecting defendant's argument that disclosure of fact

witnesses on last day of discovery was untimely, and noting that “Defendants have sat on their rights to bring any motion to reopen discovery on account of Plaintiffs’ last-minute disclosure.... [A]ny prejudice is caused by Defendants’ own dilatory conduct.”). Additional reasons not to exclude this evidence are set forth in Glidewell’s currently filed responses to Keating’s evidentiary objections.

**b. Dentists’ Testimony Supports Nongenericness**

Keating also contends that the testimony of Drs. Doneff, Newman, Cohen, Luke, Bell, Toca, and Michiels is “insufficient to support the validity” of the BruxZir mark because it supposedly is only evidence of “minority use.” (Dkt. #118 at 14:17-24) Keating is either confused or is attempting to confuse the Court. Of course these seven dentists are but a “minority” of the thousands of dentists in the United States, but that does not render their testimony evidence of mere “minority use.” These dentists testify that they have known, both before and after April 2011, and through various communications with other dentists, are aware that other dentists have known, that the BruxZir mark is a brand or trademark that signifies a single source of zirconia crowns and bridges. (SAF 13). They also attest to the fact that, both before and after April 2011, they, and other dentists with whom they regularly communicate, used the term ‘bruxer’ exclusively to refer to a person who suffers from bruxism (i.e., habitual and destructive grinding of the teeth and clenching of the jaw) and not to refer to zirconia crowns and bridges as a type or category of product. (SAF 14).<sup>6</sup> Given that Keating’s thirteen dentists (and Eggleston) each fails to testify as to genericness of “bruxzir” or “bruxer” *as of April 2011*, the testimony of Drs. Doneff, et al. is un rebutted by any contrary dentist testimony. There is no basis to view it as evidencing mere “minority use” among dentists.

<sup>6</sup> When referring to zirconia crowns and bridges as a type or category of product generally, these dentists, and the dentists that they communicate with, use “zirconia crowns,” “all zirconia crowns,” “monolithic zirconia crowns,” “full zirconia crowns,” or “solid zirconia crowns.” (SAF 14). This is the same terminology seen in the declarations from Keating’s thirteen dentists. (SAF 88)

c. **Experts' Testimony Supports Nongenericness**

Dr. Goldstein opines that “dentists do not refer to solid zirconia crowns as ‘bruxers’ or ‘bruxer crowns,’” and that “dentists do not understand the mark BruxZir to refer to solid zirconia crowns from any source, but rather ... dentists understand the mark BruxZir to identify the source of solid zirconia crowns and material to make solid zirconia crowns – the solid zirconia crowns supplied by Glidewell.” (SAF 22). Keating has little to say in rebuttal, other than that other parts of Goldstein’s testimony support descriptiveness rather than suggestiveness. (Dkt. 118 at 16:3-19) This hardly undermines his testimony as to nongenericness.

In addition, Dr. DiTolla opines that “‘bruxer’ is not a commonly used term in the dental field for crowns. Instead, the term ‘bruxer’ refers to an individual who suffers from bruxism ....” Dkt. 90-1 (Ex. P, DiTolla Decl., ¶ 12). He also opines that “the BruxZir name has attained in the minds of dentists a strong identifying source with Glidewell.” Dkt. 90-1 (Ex. P, DiTolla Decl., ¶ 11). Keating’s brief is silent as to this, other than the meaningless comment that Dr. DiTolla “admits that the terms bruxer and bruxism are taught in dental school.” (Dkt. #118 at 16:17-18)

Finally, Keating lodges a litany of attacks on Prof. Franklyn’s testimony, most centering on procedural aspects such as purported untimeliness. Glidewell responds to each of Keating’s evidentiary objections in its concurrently filed Response to Defendant Keating Dental Arts, Inc.’s Objections to Declaration and Expert Reports of David Franklyn Submitted in Support of Glidewell’s Motions for Partial Summary Judgment. If the Court overrules Keating’s objections, as it should, Franklyn’s testimony also strongly supports nongenericness.

B. **Keating Has Failed to Demonstrate a Genuine Issue of Material Fact as to Suggestiveness**

Keating admits that neither “bruxzir” nor “bruxer” are found in dictionaries. Dkt. #124, at 20:22-27. Keating also admits that its marketing materials include explanatory language with its KDZ Bruxer mark. Dkt. #124, at 21:2-16. Both facts



1 indicate suggestiveness. *Zobmondo Enter.*, 602 F.3d at 1116; *id.* at 1120 n.12  
 2 (noting that infringer’s use of explanatory language with its mark “cuts against the  
 3 ... argument that [the mark] is a well-established, culturally-pervasive concept”).

4 Keating argues that “no imagination or mental leap is necessary with  
 5 BruxZir,” (Dkt. #118 at 20:21-22), but the “imagination test” is not so easily  
 6 flunked as Keating supposes. In *Lahoti v. Vericheck, Inc.*, the Ninth Circuit  
 7 affirmed a finding that VERICHECK was suggestive, observing that “consumers  
 8 must separate ‘veri’ from ‘check’ and reason that ‘veri’ is short for verification  
 9 services.” 636 F.3d 501, 506 (9th Cir. 2011); *see also Conversive, Inc. v.*  
 10 *Conversagent, Inc.*, 433 F. Supp. 2d 1079, 1088 (C.D. Cal. 2006) (finding  
 11 CONVERSIVE and CONVERSIVE AGENT suggestive for computer software that  
 12 allowed for interaction between a human website user and a computer-generated  
 13 customer service “agent”). Here, to understand the mark’s relationship to the  
 14 product, dentists must first separate “brux” from “zir.” They must then reason that  
 15 “brux” suggests strength and possible uses for the product (e.g., treating patients  
 16 with bruxism). They must also reason that “zir” is short for zirconia. They must  
 17 then reason that “zir” suggests the product’s material. As with the mark considered  
 18 in *Lahoti*, the BruxZir mark does not describe the product’s features or nature, but  
 19 merely suggests them, requiring multi-step reasoning by the consumer. That it  
 20 might convey some information about the product does not render it descriptive or  
 21 preclude it from being suggestive. *Zobmondo Enter.*, 602 F.3d at 1114, 1119.

22 Keating next argues that “the evidence shows that not only do Glidewell’s  
 23 competitors need to use the terms brux and bruxer, they actually use the terms  
 24 currently.” (Dkt. #118 at 21:13-15) But Keating’s cited evidence of this –Drake’s  
 25 ZIR-CAST mark – contains neither brux nor bruxer. Keating then cites its SUF 60-  
 26 62, already addressed above, which does not support descriptiveness over  
 27 suggestiveness. Oddly, Keating ignores the Frattura declaration, which describes  
 28 Showcase Dental as a “direct competitor” of Keating and Glidewell. (SAF 100).



Frattura does not say that Showcase needs to use “bruxer” or “bruxzir,” and in fact her testimony establishes the opposite by pervasively using “full contour zirconia crown” and “all-zirconia crown,” rather than “bruxer crown” or “bruxzir crown,” to describe zirconia crown products. (SAF 102). Moreover, when asked by Glidewell in January of 2012 to stop using the name “Zir-Bruxer,” Frattura did not protest that Showcase needed to use “bruxer.” She instead responded that “[a] name of a crown is not going to change a single part of my customer’s satisfaction of my products or whether they use my lab *or even request this product.*” (SAF 103). (emphasis added). Shortly after, Showcase announced: “We have hereby changed the name of our product to reflect the shape and product make-up: ‘Full Contour Zirconia.’” (SAF 104). Obviously, it did not *need* to use “bruxzir” or “bruxer” *in its mark*.

**C. Keating Has Failed to Demonstrate a Genuine Issue of Material Fact as to Secondary Meaning**

Keating contends that “Glidewell “is not entitled to a presumption of secondary meaning unless the Trademark Examiner required proof of secondary meaning as part of the application for registration of the mark.” (Dkt. #118 at 22:9-12) It is true that a footnote in *Zobmondo* supports this. *See Zobmondo Enter.*, 602 F.3d 1108 at 1114 n.7. But it is also true that long-standing Ninth Circuit precedent is to the contrary, and it is doubtful that the Ninth Circuit intended to overrule itself by footnote. *See Americana Trading Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1287 (9<sup>th</sup> Cir. 1992) (“[R]egistration carries a presumption of secondary meaning. [Defendant] therefore had the burden to prove that secondary meaning had not attached if it wished to argue that [plaintiff’s] mark was weak.”); *see also Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 876 (9<sup>th</sup> Cir.1999); *Conversive*, 433 F. Supp. 2d at 1088; Ninth Cir. Model Jury Instr. 15.10, cmt. (incorporating *Americana Trading* in a model instruction “approved 11/2010,” after *Zobmondo*).

But even if the burden rests with Glidewell and not Keating, Glidewell has easily carried it by submitting copious evidence on the secondary meaning factors,

1 including evidence specific to the period through April 2011. (Dkt. 82-1 at 20:1-  
 2 24:12; Dkt. #114 at 22:4-25:16) This evidence is largely un rebutted, at least  
 3 substantively. Keating's complaints about timeliness and admissibility are  
 4 addressed in Glidewell's concurrently filed responses to Keating's various  
 5 evidentiary objections, and Glidewell's arguments need not be repeated here.

6 One final point. In its brief, Keating asserts that, after it was sued in August  
 7 2011, it "initiated a policy" of "calling dentists who wrote 'BruxZir' ... on their  
 8 prescription forms submitted to Keating" in order to educate them that "BruxZir" is  
 9 Glidewell's trademark and to confirm that the dentists wanted Keating's product  
 10 and not another lab's product.<sup>7</sup> (Dkt. #118 at 11:16-21) Perhaps so, but manifestly  
 11 this was *not* Keating's policy during the several months between the introduction of  
 12 "KDZ Bruxer" in April 2011 and the filing of the lawsuit in August.

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 24 <sup>7</sup> Keating argues that, "[u]nder Fed. R. Evid. 407, evidence of actions taken by  
 25 defendants taken to reduce potential liability cannot be relied upon as an  
 26 admission." (Dkt. #118 at 11:6-13) This argument is misplaced; Keating's own  
 27 authority states that Rule 407 does not exclude evidence of remedial measures if  
 28 proffered for a purpose other than proving "negligence, culpable conduct, a defect  
 in a product, a defect in a product's design, or a need for a warning or instruction."  
*Interactive Health LLC v. King Kong USA, Inc.*, 2008 U.S. Dist. LEXIS 123559,  
 \*20 (C.D. Cal. July 24, 2008). Here, Glidewell proffered evidence showing  
 Keating's acknowledgement that "BruxZir" is Glidewell's proprietary mark, and  
 that Keating has had to correct confusion. This is permissible under Rule 407.

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### III. CONCLUSION

For the reasons set forth above and in Glidewell's opening brief, Glidewell respectfully moves the Court to enter summary judgment in favor of Glidewell as to Keating's First Affirmative Defense and its Fourth Counterclaim (for cancellation of Registration No. 3,739,663).

Dated: December 3, 2012

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***Glidewell Laboratories v. Keating Dental Arts, Inc.***  
**United States District Court, Central, Case No. SACV11-01309-DOC (ANx)**

**CERTIFICATE OF SERVICE**

I hereby certify that on December 3, 2012, I electronically filed the document described as **JAMES R. GLIDEWELL DENTAL CERAMICS, INC.'S REPLY IN SUPPORT OF GLIDEWELL'S MOTION FOR PARTIAL SUMMARY JUDGMENT AS TO KEATING'S INVALIDITY DEFENSE AND COUNTERCLAIM** with the Clerk of the Court using the CM/ECF System which will send notification of such filing to the following:

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